

REMARKS

Reconsideration and withdrawal of the restriction requirement are respectfully requested in view of the remarks herewith.

It is believed that no fee is required for the consideration of the paper. If, however a fee is required, the Assistant Commissioner is authorized to charge such fee, or credit any overpayment, to Deposit Account No. 50-0320.

The November 12, 2002 Office Action required an election under 35 U.S.C. § 121 from:

Group I. Claims 22-43, 48, and 49, drawn to methods of treatment, classified in class 514, subclass 407; and

Group II. Claims 44-47, drawn to methods to dual application, classified in class 424, subclass 405.

The November 12, 2002 Office Action identifies that claims 22-49 are generic and requires an election of species from among the species of formula I and II.

The invention of Group I, claims 22-43, 48 and 49, drawn to methods of treatment, is elected, for further prosecution in this application. This election is made *with traverse* and is made without prejudice to Applicants' right to file divisional applications directed to the non-elected subject matter. It is respectfully requested that the restriction requirement be favorably reconsidered and withdrawn.

The species fipronil is also elected, wherein R₁ is CN, R₂ is SOR₃, R₃ is F₃, R₄ is NR₅R₆, R₅ is H, R₆ is H, R₇-R₁₀ are not applicable, R₁₁ is Cl, R₁₂ is Cl, and X is CR₁₂. This election is also made *with traverse* as the species are each related to one another and are capable of being simultaneously searched.

It is understood that the Examiner can broaden the search to include other species, e.g., upon determining that a species is allowable, or as discussed herein, when there is a relationship among the species and/or number of species is not too great. It is understood that upon the allowance of a generic claim, Applicants will be entitled to consideration of claims to additional species which are written in dependent form or which otherwise include all of the limitations of an allowed generic claim as provided by 37 C.F.R. § 1.141.

Applicants respectfully urge that the Restriction Requirement does not establish that searching both inventions constitutes an undue burden to the Patent Office. Moreover, Applicants urge that the Restriction Requirement is contrary to public policy. Accordingly, Applicants submit that the Restriction Requirement is improper and should be withdrawn.

The MPEP lists two criteria for a proper restriction requirement. First, the invention must be independent or distinct. MPEP § 803. Second, searching the additional invention must constitute an undue burden on the examiner if restriction is not required. *Id.* The MPEP directs the examiner to search and examine an entire application “[i]f the search and examination of an entire application can be made without serious burden, ... even though it includes claims to distinct or independent inventions.” *Id.*

Applicants urge that the Restriction Requirement does not meet the second of these criteria as the search does not present an undue burden on the Examiner and claims of Groups I and II overlap. The fact that Applicants received first action on the merits involving claims of both Group I and II supports the position that it is not an undue burden to search all the claims. The prosecution history demonstrates that the Examiner has already performed the required search on claims 22, 23, 28, 31-36 and 38-49, involving the claims of both Group I and Group II. Specifically, the Applicants added claims 22-49 in an amendment filed April 11, 2001.

Thereafter, the Examiner issued an Office Action, dated June 6, 2001, rejecting claims 22, 23, 28, 31-36 and 38-49, and withdrawing claims 24-27, 29, 30 and 32 as non-elected subject matter. The Examiner searched the claims from both Group I, *i.e.* 22, 23, 28, 31-36, 38-43 and Group II, *i.e.* 44-47. Thus, searching the claims of Groups I and II can be made without serious burden.

Additionally, the present claims represent a web of knowledge and continuity of effort that merits examination in a single application. Indeed, the claims of Groups I and II are related since the claims of Group II comprise units of the compositions recited in the claims of Group I. Moreover, all of the claims are directed to the eradication of fleas in domestic or laboratory mammals using a parasitically effective amount of compounds of formula (I) or formula (II).

In this regard, the Examiner's attention is respectfully requested to review MPEP § 808.02 which states, "even with patently distinct inventions, restriction is not (emphasis added) required unless one of the following reasons appears:

1. Separate classification;
2. Separate status in the art; or
3. Different field of search[.]"

Contrary to the guideline mandated by the MPEP, Groups I and II involve eradication of fleas utilizing a parasitically effective amount of compounds of formula (I) or formula (II), thereby encompassing the same field of search. Thus, restriction is not appropriate.

Additionally, the Examiner's attention is further respectfully invited to review the text of MPEP § 803 which in part states:

If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it

includes claims to distinct or independent inventions
(emphasis added).

There is no showing in the Office Action that there would be any undue or serious burden in examining Groups I and II in this application. That is, there has been no showing of any undue or serious burden in searching and examining the method of killing fleas utilizing a parasitically effective amount of compounds of formula (I) or formula (II). The link between the groups is the parasitically effective amount of the compounds of formula (I) or formula (II). Consequently, there is a concept that links the Groups and shows that search and examination should not be serious or undue. Accordingly, it is respectfully submitted that the Office Action is fatally defective and the restriction requirement cannot stand.

In summary, enforcing the present restriction requirement would result in inefficiencies and unnecessary expenditures by both the Applicants and the PTO, as well as extreme prejudice to Applicants (particularly in view of GATT, a shortened patent term may result in any divisional applications filed). Restriction has not been shown to be proper, especially since the requisite showing of serious burden has not been made in the Office Action and there are relationships between the claims of both Groups. Indeed, the search and examination of each Group is likely to be co-extensive and, in any event, would involve such interrelated art that the search and examination of the entire application can be made without undue burden on the Examiner. All of the preceding, therefore, mitigate against restriction.

Further, it is respectfully urged that restricting the claims in the manner suggested in the Restriction Requirement constitutes an undue burden to Applicants as well as the public. The cost of prosecuting and maintaining so many patents is unreasonable in view of the fact that the two groups are so closely related. Further, the public is inconvenienced as they will not

know whether or not Applicants will file a divisional application to the remaining subject matter. Accordingly, the public will not know if they can practice the remaining invention without infringing future patent application.

In response to the Requirement for an Election of Species, Applicants elect the species fipronil. Claims 22, 23, 28, 30-36 and 38-49 read upon the elected species. Applicants urge that this Requirement is improper as the Office Action does not established that searching all the species constitutes an undue burden and because it is contrary to public policy. Accordingly, reconsideration and withdrawal of this Requirement is respectfully requested.

The Office Action does not establish that searching all the species constitutes an undue burden. Given the fact that the claims are directed to the eradication of fleas in domestic or laboratory mammals using a parasitically effective amount of a compound of formula (I) and formula (II), one would expect that the individual compositions would be searched in the same class. Thus, while distinct, search all the compositions would not constitute an undue burden to the Office.

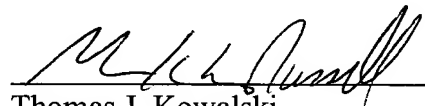
Further, it is respectfully urged that restricting the claims in the manner suggested in the Requirement would constitute an undue burden to Applicants as well as the public. Hence, it is against public policy. If followed, the Requirement would force Applicants to file numerous applications directed to various combinations of formula (I) or formula (II). The cost of prosecuting and maintaining so many patents is unreasonable in view of the fact that the application only contains twenty-seven claims and one does not know how many applications to file as the Requirement does not identify how many separate inventions are present in the claims. In addition, under GATT, the period of exclusivity for any patents which issue from the divisional application is greatly reduced. Similarly, the public is inconvenienced as they will not

know whether or not Applicants will file divisional applications to the remaining subject matter. Accordingly, the public will not know if they can practice the remaining invention without infringing future patent applications. Accordingly, in view of the foregoing, reconsideration and modification of this Requirement for an election of species is requested.

Accordingly, in view of the foregoing, reconsideration and modification of this restriction requirement is requested and an early action on the merits is earnestly solicited.

Respectfully submitted,
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